

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent No.: 7,101,550

Inventors: Clive Wood et al.

Art Unit: 1644

Serial No: 10/068,215

Attorney Docket No. DFS-067.02

Filed: February 6, 2002

Examiner: OUSPENSKI, ILIA I

For: PD-1, A RECEPTOR FOR B7-4, AND
USES THEREFOR

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF DECISION ON APPLICATION
FOR PATENT TERM ADJUSTMENT

Sir:

Patentees request reconsideration of the decision issued March 20, 2007 denying their application for patent term adjustment (PTA) under 37 C.F.R. § 1.705(d). The Commissioner is authorized to charge any fee required by the filing of this paper to Deposit Account No. 06-1448, ref. DFS-067.02.

Patentees request reconsideration because the Office's decision did not address one of Patentees' arguments, namely, that the Issue Notification tolled any post-allowance delay attributable to Patentees.

This request for reconsideration is timely because it is filed within two months of the mail date of the decision denying Patentees' original request.

A. Statement of Facts

Patentees hereby incorporate by reference the "Statement of Facts" from their original application for patent term adjustment and summarize pertinent facts here.

1. Application No. 10/068,215 was filed on February 6, 2002.
2. The Notice of Allowance was mailed on February 22, 2006 and included a determination, with which Patentees agree, that the PTA to that date was 296 days.

3. The Issue Fee payment was filed on May 22, 2006, along with a set of formal drawings.

4. The Issue Notification was mailed on August 16, 2006. It listed the projected issue date as September 5, 2006 and indicated a revised patent term adjustment of 287 days.

5. The application issued as U.S. Patent No. 7,101,550 on September 5, 2006.

B. Argument

Patentees ask the Office to correct the PTA for the above-referenced patent from 287 days to 307 days, an increase of 20 days, because the 20 days that elapsed between the mailing of the Issue Notification and the issuance of the patent did not result from Patentees' failure to engage in reasonable efforts to conclude prosecution of the application.

In the decision denying Patentees' application for patent term adjustment, the Office took the position that the patent term adjustment was "reduced by an additional 107 days in connection with the drawings submitted May 22, 2006 in accordance with 37 CFR 1.704(c)(10). The reduction began May 22, 2006, the date the drawings were submitted, and ended September 5, 2006, the date the patent issued" (Decision mailed March 20, 2007, page 2, second full paragraph).

But Patentees argued in their original application for PTA that the Issue Notification, mailed August 16, 2006, constituted "the Office action or notice in response to the . . . such other paper" under 37 C.F.R. § 1.704(c)(10)(i). As a result, the period of delay caused by the filing of the formal drawings ended August 16, 2006, or 20 days earlier than the patent issue date. The Office's Decision did not address this argument made by Patentees. Consequently, Patentees ask the office to reconsider the argument on this point.

The Issue Notification was an indication to Patentees that no further information or submission was required from the Applicant to complete the issuance process, and that the Office had scheduled issuance of the patent on September 5, 2006. The Office must have reviewed and accepted the formal drawings; otherwise, the Office of Patent Publication would not have authorized the mailing of the Issue Notification. M.P.E.P. § 1309 makes

clear that an Issue Notification is mailed only once all requirements for issuance have been met. Hence, any delay attributable to Patentees did not occur once the Issue Notification had been mailed and final preparations for issuance were underway. Consequently, the 20 days between the Issue Notification and the issuance of the patent are not delay attributable to Patentees; indeed, they result from normal processing common to all applications and constitute no delay at all.

For the reasons given above, Patentees ask the Office to reconsider its decision dismissing Patentees' application for patent term adjustment and to correct the PTA to 307 days.

Respectfully submitted,
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